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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/553,767 | 10/19/2005 | Zenon Lysenko | 62260A | 7734 |

109 7590 06/18/2008

The Dow Chemical Company
Intellectual Property Section
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| EXAMINER | |
|---|---|
| WINKLER, MELISSA A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1796 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/18/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/553,767 | LYSENKO ET AL. | |
| | Examiner | Art Unit | |
| | MELISSA WINKLER | 1796 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *19 February 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *12-23,27-40 and 42-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *12-23,27-40, and 42-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/12/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election with traverse of Group 1, drawn to a vegetable oil based polyol, in the reply filed on February 19, 2008 is acknowledged. The traversal is on the ground(s) that examination of both Groups I and II would not represent a serious burden. This is not found persuasive because serious burden is not a factor in restrictions based on PCT Rule 13.2.

The requirement is still deemed proper and is therefore made FINAL.

Claims 27 – 40, 43, and 44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 19, 2008.

The elected species A3 was not found during the prior art search. However, for the purposes of advancing prosecution, the search was subsequently continued for the non-elected species, A1 and A2.

*Claim Rejections - 35 USC § 112*

**Claims 12 – 23, 27 - 40, and 42** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 sets forth A may be comprised of A3 units in an amount of c, wherein c may be zero. This would indicate that A3 is not necessarily required to be part of the polyol. However, this is contradicted by the current amendment which requires the amount of A3 to be atleast 0.05 weight percent of the vegetable oil based polyol. For the purposes of further examination, the claim will be interpreted as wherein c may be zero.

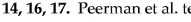
*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

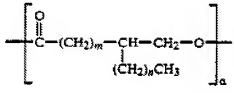
> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 12 – 17, 19, 21 – 23, and 42** are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,543,369 to Peerman et al.

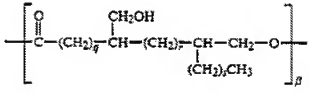
**Regarding Claims 12 – 14, 16, 17.** Peerman et al. teach a vegetable oil-based polyol (Column 3, Lines 14 – 57), represented by the formula:



where R is a polyol residue; *p* is an integer from 2 to 6; and A, which may be the same or different, is selected from the group consisting of $A_1$, $A_2$, and $A_3$ were $A_1$ is:



and $A_2$ is:



where *m*, *n*, *q*, *r*, *s*, $\alpha$, and $\beta$ are integers such that *m* is greater than 3, *n* is greater than or equal to zero, and the sum of *m* and *n* is from 11 to 19, inclusive; *q* is greater than 3, *r* and *s* are each greater than or equal to zero, and the sum of *q*, *r*, and *s* is from 10 to 18, inclusive (Column 2, Line - Column 3, Line 10).

**Regarding Claim 15.** Peerman et al. teach the polyol of Claim 12 wherein the initiator may have a secondary hydroxyl group, such as that present in 1,4-bishydroxymethylcyclohexane (Column 12, Lines 39 - 41).

**Regarding Claim 19.** Peerman et al. teach the polyol of Claim 12 wherein the initiator may be neopentylglycol (Column 5, Lines 17 – 31).

**Regarding Claims 21 – 23.** Peerman et al. teach the polyol of Claim 12 wherein the polyols in the Examples have hydroxyl equivalent weights ranging from 157 to 602 (Column 11, Line 35 - Column 13, Line 50).

**Regarding Claim 42.** Peerman et al. teach the polyol of Claim 12 wherein the polyol is reacted with a polyisocyanate to form a polyurethane (Column 8, Line 53 – Column 9, Line 52).

**Claim 18** is rejected under 35 U.S.C. 102(b) as being anticipated by US 4,543,369 to Peerman et al., as applied to Claims 12, 16, and 17 above, and further in view of US 4,216,344 to Rogier.

**Regarding Claim 18.** Peerman et al. teach the polyol of Claim 17 wherein triols disclosed in US 4,216,344 to Rogier may be used. Rogier specifically discloses the triol may be glycerol (Column 11, Lines 53 – 58).

**Claim 20** is rejected under 35 U.S.C. 102(b) as being anticipated by US 4,543,369 to Peerman et al., as applied to Claims 12 and 19 above, and further in view of US 4,216,344 to Rogier.

**Regarding Claim 20.** Peerman et al. teach the polyol of Claim 19 wherein triols disclosed in US 4,216,344 to Rogier may be used. Rogier specifically discloses the triol may be glycerol (Column 11, Lines 53 – 58).

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claim 12** is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 3 of copending Application No. 11/665,097. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variations upon each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA WINKLER whose telephone number is (571)270-3305. The examiner can normally be reached on Monday - Friday 7:30AM - 5PM E.S.T..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MW
June 9, 2008

/James J. Seidleck/
Supervisory Patent Examiner, Art Unit 1796